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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,461	01/20/2004	Kang Soo Seo	46500-000123/US	7834
36593 7590 03/11/2008 HARNES, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195				
EXAMINER				
KHAN, ASHER R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,461

Applicant(s)

SEO ET AL.

Examiner

ASHER KHAN

Art Unit

4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 2/25/2008 3/24/005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 1-27 define a recording medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 8-12, 14-17, 21-24 and 26-27** are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Pub. 2002/0164152 A1 to *Kato et al.* ("*Kato*").

As to **claims 1, 26 and 27** *Kato* discloses a recording medium having a data structure for managing reproduction of still pictures, comprising: a playlist area storing at least one playlist file, the playlist file including at least one playitem (Fig. 7)(0154), at least one sub-playitem (Fig. 7)(0186) and mark information (0160)(0190), the playitem providing navigation information for reproducing at least one still picture from a first file (0191)(0199-0200)(Fig. 7) (0184) , the sub-playitem associated with the playitem and providing navigation information for reproducing audio data from a second file, and the mark information includes at least one mark pointing to the still picture (0190-0192)(0298)(Fig. 83).

As to **claim 2**, *Kato* further discloses wherein the mark includes a mark type indicator indicating that the mark is of a type used for pointing to a still picture (0193-0194).

As to **claim 3**, *Kato* further discloses wherein the mark includes a time stamp indicating a time address of the still picture in the first file (0189).

As to **claim 4**, *Kato* further discloses wherein the mark includes a playitem indicator indicating the playitem with which the mark is associated (0189) (0190)(Fig. 44)(0294).

As to **claim 8**, *Kato* further discloses wherein the mark includes a time stamp indicating a time address of the still picture in the first file (0189)(0299).

As to **claim 9**, *Kato* further discloses wherein the mark includes a playitem indicator indicating the playitem with which the mark is associated (0189) (0190)(Fig. 44)(0294).

As to **claim 10**, *Kato* further discloses wherein the mark information includes a number of marks, and the mark information includes a number indicator indicating the number of marks (0298).

As to **claim 11**, *Kato* further discloses wherein, for each mark, the mark information provides a type indicator indicating a type of the mark (0190)(Fig. 44)(0294)(0298)(Fig. 43).

As to **claim 12**, *Kato* further discloses wherein the playitem provides navigation information for reproducing presentation data from the first file (Fig. 7; 0184)(0414), the presentation data including at least the still picture and associated related data (0192)(0414).

As to **claim 14**, *Kato* discloses recording medium having a data structure for managing reproduction of still images, comprising:
a data area storing at least one clip file, the clip file including presentation data, the presentation data including at least one still picture and related data associated with the still picture(0160)(0190)(1092); and a playlist area storing at least one playlist file, the playlist file including playlist mark information, the playlist mark information including at least one mark pointing to the still picture(0160)(0189)(0190)(0192).

As to **claim 15**, *Kato* further discloses wherein the mark includes a mark type indicator indicating that the mark is of a type used for pointing to a still picture (0193-0194).

As to **claim 16**, *Kato* further discloses wherein the mark includes a time stamp indicating a time address of the still picture in the first file (0189).

As to **claim 17**, wherein the mark includes a playitem indicator indicating the playitem with which the mark is associated (0189) (0190)(Fig. 44)(0294).

As to **claim 21**, *Kato* further discloses wherein the mark includes a time stamp indicating a time address of the still picture in the first file (0189)(0299).

As to **claim 22**, *Kato* further discloses wherein the mark includes a playitem indicator indicating the playitem with which the mark is associated (0189) (0190)(Fig. 44)(0294).

As to **claim 23**, *Kato* further discloses wherein the mark information includes a number of marks, and the mark information includes a number indicator indicating the number of marks (0298).

As to **claim 24**, *Kato* further discloses wherein, for each mark, the mark information provides a type indicator indicating a type of the mark (0189) (0190)(Fig. 44)(0294)(0298)(Fig. 43).

As to **claim 28**, *Kato* discloses an apparatus for recording a data structure for managing reproduction of at least one still image on a recording medium, comprising:

a driver for driving an optical recording device to record data on the recording medium (Fig. 1, write unit 22);

a controller for controlling the driver to record at least one playlist file on the recording medium (Fig. 1, controller 23), the playlist file including at least one playitem (Fig. 7)(0154), at least one sub-playitem(Fig. 7)(0186) and mark information(0160)(0190), the playitem providing navigation information for reproducing at least one still picture

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from a first file, the sub-playitem associated with the playitem and providing navigation information for reproducing audio data from a second file, and the mark information includes at least one mark pointing to the still picture (0190-0192)(0298)(Fig. 83).

As to **claim 29**, *Kato* discloses an apparatus for reproducing a data structure for managing reproduction of at least one still image recorded on a recording medium, comprising:

a driver for driving an optical reproducing device to reproduce data recorded on the recording medium(Fig. 1, write unit 23);

a controller for controlling the driver to reproduce at least one playlist file from the recording medium, (Fig. 1, controller 23), the playlist file including at least one playitem (Fig. 7)(0154), at least one sub-playitem (Fig. 7)(0186) and mark information (0160)(0190), the playitem providing navigation information for reproducing at least one still picture from a first file, the sub-playitem associated with the playitem and providing navigation information for reproducing audio data from a second file, and the mark information includes at least one mark pointing to the still picture (0190-0192)(0298)(Fig. 83).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 5-7 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2002/0164152 A1 to *Kato et al.* ("*Kato*") in view of U.S. Patent Pub. 2005/0163463 A1 to *Schick et al.* ("*Schick*").

As to **claims 5 and 18**, *Kato* discloses wherein the mark includes a mark type indicator indicating that the mark is of a type that provides a point to skip to (Fig. 43).

Kato doesn't expressly disclose when displaying a slideshow of still pictures.

Schick discloses a point to skip to while displaying a slideshow of still pictures (See figs. 4, 7, 16 and 0143).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine *Kato* with *Schick*. Motivation would have been to provide a skipping function having a "skip increment" in a slide show to skip between multiple images (0143).

As to **claims 6 and 19**, *Kato* further discloses wherein the mark includes a time stamp indicating a time address of the still picture in the first file (0189)(0299).

As to **claims 7 and 20**, *Kato* further discloses wherein the mark includes a playitem indicator indicating the playitem with which the mark is associated (0189) (0190)(Fig. 44)(0294).

Therefore, it would have been obvious to combine *Kato* and *Schick* to make the modifications as described in claims 5-7 and 18-20.

6. **Claims 13 and 25** are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent Pub. 2002/0164152 A1 to *Kato et al.* ("*Kato*") in view of U.S. Patent No. 6122436 to *Okada et al.* ("*Okada*").

As to **claim 13**, *Okada* discloses comprising: a data area storing the first file and the second file; and wherein the presentation data is divided into still picture units in the first file such that each still picture unit includes a still picture and associated related data (Abstract).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine *Kato* with *Okada*. Motivation would have been so that audio data (second file) can freely and easily be changed even after recording the still picture data (Abstract)

As to **claim 25**, claim 25 cites" wherein the presentation data is divided into still picture units in the clip file such that each still picture unit includes a still picture and associated related data." This claim reads on claim 13.

Therefore it would have been obvious to combine *Kato* with *Okada* to make the modification of claims 13 and 25.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on Monday-Friday 9:30 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lun - Yi can be reached on (571)272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./
Examiner, Art Unit 4134

/Lun-Yi Lao/
Supervisory Patent Examiner, Art Unit 4134